

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES MORRISON and JOHN C. ADDY

Appeal No. 2002-0015
Application No. 09/164,098

ON BRIEF

Before HAIRSTON, RUGGIERO, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 1-20. The appellants appeal therefrom under 35 U.S.C. § 134(a). We reverse.

BACKGROUND

The appellants' invention is a self-service checkout terminal. In the grocery industry, an impetus to reduce labor costs has focused on reducing the labor required to process items purchased by a customer. (Spec. at 1.) More specifically, self-service checkout terminals operated by a customer without the aid of a checkout clerk have been developed. Using such a terminal, the customer scans items for purchase and

then places the scanned items into a grocery bag. He pays for the purchase at the terminal or at a central payment area staffed by a store employee. (*Id.* at 1-2.)

While operating a self-service checkout terminal, a customer may scan an item, e.g., tobacco or alcohol, that requires verification of his age. Typically, such verification requires the intervention of a store employee. The employee must approach the customer and verify his age, e.g., by checking his driver's license. (*Id.* at 2.) Having an employee present to verify the age of a customer, however, increases labor costs. (*Id.* at 3.)

In contrast, the appellants' assert that their self-service checkout terminal verifies a customer's age without the intervention of an employee. (*Id.* at 4.) More particularly, when a customer inserts a card or enters a code in the terminal, the latter retrieves his biometric profile. (Appeal Br. at 3.) After that, the terminal detects a biometric characteristic of the customer and compares it the retrieved profile to detect if the customer is who he claims to be. The biometric characteristic may be a fingerprint pattern, an iris pattern, a facial pattern, a hand pattern, or a voice pattern. (*Id.*)

A further understanding of the invention can be achieved by reading the following claim:

1. A method of operating a self-service checkout terminal, comprising the steps of:

determining a user reported identity code associated with a user of said checkout terminal and retrieving a user biometric profile which corresponds to said user reported identity code in response thereto;

detecting if said user enters a restricted item into said checkout terminal and generating a restricted-item control signal in response thereto;

detecting a biometric characteristic of said user in response to generation of said restricted-item control signal; and

comparing said user biometric profile with said biometric characteristic and generating an identity-verified control signal if said user biometric profile matches said biometric characteristic.

Claims 1-5, 10-14, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,979,757 ("Tracy") in view of U.S. Patent No. 5,067,162 ("Driscoll"). Claims 6 and 15 stand rejected under § 103(a) as obvious over Tracy in view of Driscoll further in view of U.S. Patent No. 4,641,349 ("Flom"). Claims 7 and 16 stand rejected under § 103(a) as obvious over Tracy in view of Driscoll further in view of U.S. Patent No. 5,715,325 ("Bang"). Claims 8 and 17 stand rejected under § 103(a) as obvious over Tracy in view of Driscoll further in view of U.S. Patent No. 5,483,601

("Faulkner"). Claims 9 and 18 stand rejected under § 103(a) as obvious over Tracy in view of Driscoll further in view of U.S. Patent No. 5,761,329 ("Chen").

OPINION

Rather than reiterate the positions of the examiner or appellants *in toto*, we address the main point of contention therebetween. Admitting that Tracy "fails disclose [sic] 'determining a user reported identity code associated with a user of said checkout terminal and retrieving a user biometrics profile which corresponds to said user reported identity code in response thereto; detecting a biometrics characteristic of said user in response to generation of said restricted-item control signal; and comparing said user biometrics profile with said biometrics characteristic and generating an identity-verified control signal if said user biometrics profile matches said biometrics characteristic,'" (Examiner's Answer at 5), the examiner asserts, "using the biometrics recognition of Driscoll to replace the attendant (who is responding to generated signal) allows for a more secure system without the human element of Tracy. This combination will provide a method that will give an extra edge of projection to the service and/or retail industry by automating the apparatus and resisting any misuse because of the biometrics." (*Id.*) The appellants argue, "[w]hile the Examiner has provided a reason for the combination (see above), the Examiner has used hindsight. . . ." (Reply Br. at 3.)

“[T]o establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicants.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). “[T]he factual inquiry whether to combine references must be thorough and searching.” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). “This factual question . . . [cannot] be resolved on subjective belief and unknown authority.” *In re Lee*, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). “It must be based on objective evidence of record.” *Id.* at 1343, 61 USPQ2d at 1434.

Here, the examiner fails to show objective evidence of the desirability of replacing Tracy’s attendant with Driscoll’s biometrics recognition. His broad, conclusory statement that such a replacement “allows for a more secure system without the human element of Tracy,” (Examiner’s Answer at 5), is not evidence. More specifically, the examiner proffers no evidence that “self-checkout system[s],” Tracy, col. 6, ll. 53-54, suffer from a lack of security. Nor is there evidence that “biometric method[s] of personnel identification,” Driscoll, col. 1, l. 14, were used in shopping or checkout applications.

The examiner fails to allege, let alone show, that the addition of Flom, Bang, Faulkner, or Chen cures the aforementioned deficiency. Therefore, we reverse the obviousness rejections of claims 1-20.

CONCLUSION

In summary, the rejections of claims 1-20 under § 103(a) are reversed.

REVERSED

KENNETH W. HAIRSTON
Administrative Patent Judge

JOSEPH F. RUGGIERO
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

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